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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,209	08/05/2003	Daniel Hunter Stone	1739/29(b)	6813
23381	7590	05/11/2004	EXAMINER	
DORR CARSON SLOAN & BIRNEY, PC			YEE, DEBORAH	
3010 EAST 6TH AVENUE			ART UNIT	
DENVER, CO 80206			PAPER NUMBER	
			1742	

DATE MAILED: 05/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/634,209

Applicant(s)

STONE ET AL.

Examiner

Deborah Yee

Art Unit

1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 24 to 31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24 to 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8-5-03</u> | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 24 to 31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 6 of U.S. Patent No. 6,387,191. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both disclose a railway wheel made of a steel having a pearlitic structure; and the steel composition of pending claims have alloying constituents whose wt% ranges are within or encompass those recited by US Patent '191 claims.

Claims 24 to 31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 14 of U.S. Patent No. 6,632,297. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both disclose a railway wheel made of a steel having a pearlitic structure, and the steel composition of pending claims having alloying

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constituents whose wt% ranges are within or encompass those recited by US Patent '297 claims.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24 to 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heller et al (US Patent No. 4,230,488) submitted by applicant in IDS dated August 5, 2003.

Heller in claims 1,2 and 6 of columns 9 and 10 disclose a steel wheel alloy composition having alloying constituents whose wt% ranges overlap those recited by the claims 24 to 31. The subject matter as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made to have selected the overlapping portions of the ranges disclosed by the reference because overlapping ranges with similar properties (increase service life) have been held to establish a prima facie case of obviousness, see MPEP 2144.05. Moreover, claim 6 of column 10 of Heller discloses a very fine pearlitic structure.

Although prior art discloses the additional elements, lead and bismuth, such would not appear to affect the basic and novel characteristics of the present invention and therefore would not be excluded from the claims reciting "consisting essentially of".

Moreover, the omission of lead and bismuth with consequent loss of its function would not be a patentable distinction, see *In re Wilson et al*, 153 USPQ740.

Claims 24 to 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over admitted prior art in last paragraph on page 6 of applicant's specification (Japanese patent application 57-143465).

The prior art discloses a railway wheel steel with a fine pearlitic structure and having a composition with alloying constituents whose wt% ranges overlap or closely approximate those recited by the claims 24 to 31. The subject matter as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made to have selected the overlapping portions of the ranges disclosed by the reference because close approximation and/or overlapping ranges with similar properties (high hardness and strength) have been held to establish a prima facie case of obviousness, see MPEP 2144.05.

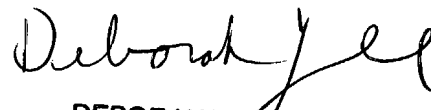
In regard to claim 31, JP'465 discloses 1.2% Si which is slightly lower than the recited Si range of 1.3 to 2.5. Since criticality of the Si range has not been demonstrated (e.g. by comparative test data), then a composition with 1.3% Si vs. a composition with slightly less(say 1.2%) Si, would depict a mere difference in the proportion of element without any attendant unexpected results. Hence claim would not patentably distinguish over prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Yee whose telephone number is 571-272-1253. The examiner can normally be reached on Monday-Friday from 6:00 to 2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

dy

  
DEBORAH YEE  
PRIMARY EXAMINER